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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	2164.004	2619
27834	7590	02/24/2005	EXAMINER	
LAW OFFICE OF RAY B. REGAN			KING, ANITA M	
P.O. BOX 1442			ART UNIT	PAPER NUMBER
CORRALES, NM 87048			3632	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/910,655  <b>Examiner</b> Anita M. King	<b>Applicant(s)</b> LIEBENDORFER, JOHN E.	
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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 03 December 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1,3-10,12-32,34-38 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) Claim(s) 38 and 41-49 is/are allowed.
- 6) Claim(s) 1,3,4,6-10,17-19,21,31,32,34 and 37 is/are rejected.
- 7) Claim(s) 5,12-16,20,22,23,35 and 36 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

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|---|--|
| <ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date <u>12/3/04</u></li> </ol> | <ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol> |
|---|--|

This is the fifth office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

***Election/Restrictions***

Claims 24-30 have withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 26, 2002.

***Cancellation of Claims***

Claims 2, 11, 33, 39, and 40 have been canceled per applicant's request.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6-10, 17-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,957,568 to Byers. Byers discloses a system for removably and adjustably mounting a device (30) on a surface, comprising: a rail (10, 40) formed with at least two tracks (14, 16, 52); wherein the at least two tracks are removably mountable on a footing grid; a plurality of keepers (80, 104) on which to mount *the at least two tracks*; wherein the at least two tracks include a channel extending the length

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of the rail; one or more clamps (64, 74, 102) for connecting; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the slot is formed at substantially right angle to the slot in any other of the at least two tracks (the slot of track 52 is formed at a right angle to the slots of tracks 14 and 16); wherein the one or more clamps is formed as a duct with at least two opposing flanges; wherein the opposing flanges of the one or more clamps are substantially perpendicular to one another (see Fig. 10); wherein the one or more clamps is formed with a leg having a base (112), a descending member (below reference number 116) monolithically extending from the base, and an ascending member (110) monolithically extending from the base in a direction substantially opposite the direction of the descending member; wherein the one or more clamps included means for connecting the device to the rail; wherein the one or more clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles to the plate; wherein the opposing side walls include a lower inner edge and n upper face, and a fin extending from the upper face substantially along the longitudinal axis of the at least one dual track rail; and wherein the one or more clamps includes means for variably positioning the one or more clamps.

Claims 31, 32, 34, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,349,912 to Schauss et al., hereinafter, Schauss. Schauss discloses a system for removably and adjustably mounting a device on a surface, comprising: a rail (1) formed with at least two tracks; wherein the at least two tracks include a slot formed at substantially a right angle to the slot in any other of the at least

two tracks; wherein the rail is formed with a body having a proximal end, a distal end, and hollow chamber therebetween; one or more clamps (2) for connecting the system to the surface; wherein the at least two tracks includes a channel extending the length of rail; wherein the one or more clamps is formed as a duct with at least two opposing flanges; and wherein the one or more clamps is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member.

***Allowable Subject Matter***

Claims 5, 12-16, 20, 22, 23, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 38 and 41-49 are allowed.

***Response to Arguments***

Applicant's arguments filed December 3, 2004 have been fully considered but they are not persuasive. The rejections advanced against the claims stand.

In response to applicant's argument that Byers describes improvements in components for mounting decorative light strings to various mounting sites, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In regards to applicant's arguments that the MPEP 211.01 does not state that pending claims must be given their broadest reasonable interpretation, the examiner disagrees, the MPEP states that during examination, the claims must be interpreted as broadly as their terms reasonably allow, applicant's specification does not provide a specific definition of the terms "track" or "channel" which are universally defined as a metal groove or ridge that holds, guides, and reduces friction for a moving device or apparatus and a trench, furrow, or groove, respectively. Byers discloses these claimed limitations based on the definition of the terms.

In regards to applicant's arguments that Byers does not disclose each and every element of the claimed invention, as stated in applicant's specification, the footing grid is comprised of the keepers which are actually drawn in phantom in Fig. 7 and would lead one to believe that they are not interpreted as elements of the claimed invention, however, they have been considered as elements of the claimed invention and the keepers (80, 104) in Byers make up the footing grid which is part of the roof in Byers' Fig. 5.

In regards to applicant's argument that Byers does not teach the limitation of one or more clamps, the examiner interprets this limitation as one clamp or more than one

clamp, Byers teaches one clamp which is referenced as 64, 74, or 102, these clamps are used to attached the track to the surface and thus, Byers discloses this limitation.

In response to applicant's argument that Schauss is directed to a supporting structure, especially for attachment to a robot arm and for securing tools, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In regards to applicant's arguments that Schauss does not teach each and every element of the claimed invention, there are four tracks having slots formed around the circumference of element 1 in Schauss, thus, Shcauss does indeed show slots that are at right angles to other slots on the element.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 3,551,876 to Walter

U.S. Patent 3,727,171 to Coles et al.

U.S. Patent 3,778,175 to Zimmer

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U.S. Patent 5,511,353 to Jones

U.S. Patent 6,360,491 to Ullman

U.S. Patent 6,561,117 to Kell

Walter discloses wireways and connector clamp. Coles et al. disclose a bus bar having a T-shaped cross section for receiving sliding connectors. Zimmer discloses a snap-locking structural joint assembly. Jones discloses a portable decking system having special clips. Ullman discloses a roof support system for a solar panel. Kell discloses an accessory mounting track.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anita M. King  
Primary Examiner  
Art Unit 3632

February 22, 2005